



1624
Docket No. JAB-1485

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Marcel Franz Leopold De Bruyn et al.
Serial No. : 09/980,451
Filed : November 30, 2001
Title : PYRROLIDINYL, PIPERIDINYL OR HOMOPIPERIDINYL
SUBSTITUTED (BENZODIOXAN, BENZOFURAN OR
BENZOPYRAN) DERIVATIVES

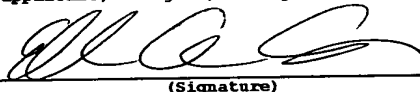
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Art Unit : 1624
Examiner : Brenda Libby Coleman

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7-9-03
(Date of Deposit)

Ellen Ciambrone Coletti
(Name of applicant, assignee, or Registered Representative)


(Signature)

7-9-03
(Date of Signature)

Honorable Commissioner of Patents
Washington, D.C. 20231

RESPONSE

Dear Sir:

This is in response to the Office Action mailed June 12, 2003 in the captioned application.

The pending claims are claims 1-7, 9 and 10.

In the Office Action, restriction is required under 35 USC §121 and 372 to the following:

Group I, claim(s) 1-3, 5-7, 9 and 10, drawn to compounds, compositions, method of use and process of preparing the compounds of formula I, where ring A is a piperidine ring.

Group II, claim(s) 1, 2, 4, 6, 7, 9 and 10, drawn to compounds, compositions, method of use and process of preparing the compounds of formula I, where ring A is a pyrrolidine ring.

Group III, claim(s) 1, 2, 6, 7, 9 and 10, drawn to compounds, compositions, method of use and process of preparing the compounds of formula I, where ring A is a tropane ring.

Group IV, claim(s) 1, 2, 6, 7, 9 and 10, drawn to compounds, compositions, method of use and process of preparing the compounds of formula I, where ring A is a azepine ring.

Group V, claim(s) 1, 2, 6, 7, 9 and 10, drawn to compounds, compositions, method of use and process of preparing the compounds of formula I, where ring A is a piperazine ring.

Group VI, claim(s) 1, 2, 6, 7, 9 and 10, drawn to compounds, compositions, method of use and process of preparing the compounds of formula I, where ring A is a diazepine ring.

Applicants hereby elect with traverse the subject matter of Group I, that is, claims 1-3, 5-7, 9 and 10, drawn to compounds, compositions, method of use and process of preparing the compounds of formula I, where ring A is a piperidine ring.

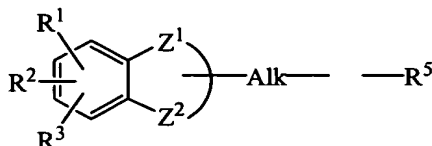
Applicants respectfully submit that the Restriction Requirement is inappropriate. In the Office Action, it is asserted that "The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

the inventions of Groups I-VI are drawn to structurally dissimilar compounds, compositions, process of preparing and method of use. They are made and used independently. One does not require the other for their use. If, say, the piperidines of Group I, were anticipated, applicants would not acquiesce in the objection of Groups II-VI there over or vice-versa and, thus, they are not linked to the same or corresponding special technical features.

Attention is directed to MPEP Section 803.02 which states, in part, that:

Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPZ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. *In re Harnish*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility and (2) share a substantial structural feature disclosed as being essential to that utility. (emphasis added)

Applicants submit that unity of invention exists for the members of the Markush group herein in that they (1) share a common utility—treating symptoms of impaired fundic relaxation and (2) share a substantial structural feature disclosed as being essential to that utility that is

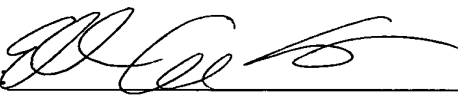


In addition, applicants note that no unity of invention objection was raised in the corresponding PCT application.

Based on the foregoing, Applicants submit that the Restriction Requirement is improper and should be withdrawn.

Applicants respectfully request examination of the captioned application and allowance of same.

Respectfully submitted,

By: 
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